

REMARKS

In the final Office Action,¹ the Examiner:

- (a) rejected claims 1-3 and 6-9 under 35 U.S.C. § 102(e) as being anticipated by Berstis (U.S. Patent No. 6,564,005) ("Berstis");
- (b) rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Berstis in view of Panjwani et al. (U.S. Publication No. 2002/0018569) ("Panjwani"); and
- (c) rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Berstis in view of Arnold (U.S. Patent No. 5,956,408) ("Arnold").

Applicants respectfully traverse the rejections for at least the following reasons.

Rejection of Claims 1-3 and 6-9 under 35 U.S.C. § 102(e):

Applicants traverse the rejection of claims 1-3 and 6-9 under 35 U.S.C. § 102(e) as being anticipated by Berstis. Berstis does not anticipate claims 1-3 and 6-9.

In order to properly establish anticipation under 35 U.S.C. § 102, the Federal Circuit has held that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). See also M.P.E.P. § 2131.

¹ The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

Berstis does not teach or suggest each and every element recited in the claims. For example, Berstis does not teach or suggest “[a] machine tool program unauthorized-use preventing device comprising: a storage section ...; a display section...; and a processing section for processing to read out, when a device inherent password inherent to the machine tool program unauthorized-use preventing device and set by a manufacturer of the machine tool program unauthorized use preventing device is input, said desired operation program selected on said first program-selection image ..., while to read out, when a machine tool inherent password different from said device inherent password, inherent to the machine tool, into which the machine tool program unauthorized-use preventing device is installed, and set by a manufacturer of the machine tool, is input, said desired operation program selected on said second program-selection image...,” as recited in independent claim 1 (emphasis added).

The Examiner alleged that “[r]e claim 1: Berstis teaches a machine tool program unauthorized-use preventing device comprising: ... a processing section [Fig 1A, elt 102] for processing to read out (col 3, lines 31-32), when a device inherent password [master user password] ... is input (Fig. 3, elts 302 & 304; col 7, lines 14-16) ..., while to read out, when a machine tool inherent password [user password] ... is input (Fig. 7, elts 402 & 404; col 8, lines 5-8),” (Office Action, p. 5-6, emphasis added). However, this is not correct.

Berstis discloses that “[t]he system prompts the master user for a password (step 302). The user enters his password (step 304), and the system authenticates him as the master user (step 306). Note that steps 300 through 306 could be replaced by various other types of security mechanisms, such as a smart card that authenticates the

master user" (col. 7, lines 14 - 22). Berstis also discloses that "the master user enters the new user's name and selects a password for the new user (step 316). Rather than setting a password, a variety of security controls may be used for each user in the system. As discussed above, these security controls may include a smart card for each user, or some other type of security mechanism" (col. 7, lines 43 - 49). However, Berstis does not teach or suggest "a processing section for processing to read out, when a device inherent password inherent to the machine tool program unauthorized-use preventing device and set by a manufacturer of the machine tool program unauthorized use preventing device is input, said desired operation program selected on said first program-selection image ..., while to read out, when a machine tool inherent password different from said device inherent password, inherent to the machine tool, into which the machine tool program unauthorized-use preventing device is installed, and set by a manufacturer of the machine tool, is input, said desired operation program selected on said second program-selection image....," as recited in claim 1 (emphasis added).

The Examiner alleged that "[o]ne of ordinary skill in the art would appreciate that the time smart cards are manufactured, they are designated to be compatible with their respective set-top-boxes/readers and may contain sensitive information ..., [and] Berstis teaches embedding the password in a hardware device, e.g., a smart card" (Office Action, p. 4). However, this does not constitute "a processing section for processing to read out, when a device inherent password inherent to the machine tool program unauthorized-use preventing device and set by a manufacturer of the machine tool program unauthorized use preventing device is input, said desired operation program

selected on said first program-selection image ..., while to read out, when a machine tool inherent password different from said device inherent password, inherent to the machine tool, into which the machine tool program unauthorized-use preventing device is installed, and set by a manufacturer of the machine tool, is input, said desired operation program selected on said second program-selection image...,” as recited in claim 1 (emphasis added). Therefore Berstis fails to teach or suggest each and every element recited in claim 1. The rejection of claim 1 and, hence, dependent claims 2, 3, and 6-9 under 35 U.S.C. § 102(e) is improper and should be withdrawn.

Rejection of Claim 1 under 35 U.S.C. § 103(a):

Applicants traverse the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Berstis in view of Panjwani. No *prima facie* case of obviousness has been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” *M.P.E.P. § 2145*. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. *M.P.E.P. § 2143.01(III), internal citation omitted*. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences

themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P. § 2141.02(I)*, internal citations omitted (emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966).... The factual inquiries ... [include determining the scope and content of the prior art and] ... [a]scertaining the differences between the claimed invention and the prior art.” *M.P.E.P. § 2141(II)*. “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” *M.P.E.P. § 2141(III)*.

As discussed above, Berstis does not teach or suggest “[a] machine tool program unauthorized-use preventing device comprising: a storage section ...; a display section...; and a processing section for processing to read out, when a device inherent password inherent to the machine tool program unauthorized-use preventing device and set by a manufacturer of the machine tool program unauthorized use preventing device is input, said desired operation program selected on said first program-selection image ..., while to read out, when a machine tool inherent password different from said device inherent password, inherent to the machine tool, into which the machine tool program unauthorized-use preventing device is installed, and set by a manufacturer of the machine tool, is input, said desired operation program selected on said second program-selection image...,” as recited in independent claim 1 (emphasis added).

Panjwani does not cure the deficiencies of Berstis. Panjwani discloses that “the mobile station and the service provider could exchange the public key over the air when

the mobile user requests service. In this case the exchange could be secured using a password established between the user and the service provider, or using a public key of the manufacturer embedded in the mobile station at manufacture time” (para. [0046]). However, neither Berstis, nor Panjwani, nor any combination thereof, teaches “a processing section for processing to read out, when a device inherent password inherent to the machine tool program unauthorized-use preventing device and set by a manufacturer of the machine tool program unauthorized use preventing device is input, said desired operation program selected on said first program-selection image ..., while to read out, when a machine tool inherent password different from said device inherent password, inherent to the machine tool, into which the machine tool program unauthorized-use preventing device is installed, and set by a manufacturer of the machine tool, is input, said desired operation program selected on said second program-selection image...,” as recited in claim 1 (emphasis added).

In addition, Panjwani does not teach or suggest “a processing section for processing to read out, when a device inherent password ... is input, said desired operation program selected on said first program-selection image ... and bring said desired operation program into a usable state, while to read out, when a machine tool inherent password ... is input, said desired operation program selected on said second program-selection image... and bring said desired operation program into a usable state,” as recited in claim 1 (emphasis added).

In view of the shortcomings discussed above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art.

Based on para. [0046] of Panjwani, the Examiner alleged that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Berstis with the teachings of Panjwani ...” (Office Action, p. 8). Applicants do not agree.

Berstis is directed to a multi-user video hard disk recorder, but Panjwani is directed to a communication system including a mobile station. Therefore, there is no motivation for one of ordinary skill in the art to modify the references to achieve the claimed combinations. Thus, the Office Action does not clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Accordingly, no *prima facie* case of obviousness has been established. Therefore, claim 1 is allowable, and the 35 U.S.C. § 103(a) rejection of claim 1 is improper and should be withdrawn.

Rejection of Claims 4 and 5 under 35 U.S.C. § 103(a):

As discussed above, Berstis does not teach or suggest “[a] machine tool program unauthorized-use preventing device comprising: a storage section ...; a display section...; and a processing section for processing to read out, when a device inherent password inherent to the machine tool program unauthorized-use preventing device and set by a manufacturer of the machine tool program unauthorized use preventing device is input, said desired operation program selected on said first program-selection image ..., while to read out, when a machine tool inherent password different from said device inherent password, inherent to the machine tool, into which the machine tool program unauthorized-use preventing device is installed, and set by a manufacturer of the machine tool, is input, said desired operation program selected on said second

program-selection image...,” as recited in claim 1 and required by dependent claims 4 and 5 (emphasis added).

Arnold does not cure the deficiencies of Berstis. The Examiner alleged that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to have been modified Berstis to validate external data usable by said security device for the purpose of using authenticate data provided on an external medium” (Office Action, p. 9). However, whether this allegation is correct or not, neither Berstis, nor Arnold, nor any combination thereof, teaches “a processing section for processing to read out, when a device inherent password inherent to the machine tool program unauthorized-use preventing device and set by a manufacturer of the machine tool program unauthorized use preventing device is input, said desired operation program selected on said first program-selection image ..., while to read out, when a machine tool inherent password different from said device inherent password, inherent to the machine tool, into which the machine tool program unauthorized-use preventing device is installed, and set by a manufacturer of the machine tool, is input, said desired operation program selected on said second program-selection image...,” as recited in claim 1 and required by dependent claims 4 and 5 (emphasis added).

In view of the shortcomings discussed above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Moreover, there is no motivation for one of ordinary skill in the art to modify the references to achieve the claimed combinations. Thus, the Office Action does not clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill

in the art. Accordingly, no *prima facie* case of obviousness has been established. The 35 U.S.C. § 103(a) rejection of claims 4 and 5 is improper and should be withdrawn.

Conclusion:

In view of the foregoing, Applicants request reconsideration of the application and withdrawal of the rejections. Pending claims 1-9 are in condition for allowance. Accordingly, Applicants request a favorable action.

If there are any remaining issues or misunderstandings, Applicants request the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 9, 2009

By: 

Robert E. Converse, Jr.
Reg. No. 27,432